

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 103 rejections, the Office has failed to provide requisite motivation to modify Nagata and the Office has failed to establish a *prima facie* 103 rejection for at least this reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and *the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness*. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

The Federal Circuit discussed proper motivation *in re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *in re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *in re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective*

PDNO. 10007611-1
Serial No. 09/932,631
Amendment C

*belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed. The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references. The statement on page 15 of the Action that it would have been obvious to modify Nagata to obtain the claimed invention is insufficient and the 103 rejections are improper.*

Applicants hereby add new claims 34-42 which are supported at least by Figs. 2, 3, 5 and 6 and the associated specification teachings of the originally filed application.


Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Quintin T. Phillips et al.

By:


James D. Shaurette
Reg. No. 39,833
Date: 9/28/06

PDNO. 10007611-1
Serial No. 09/932,631
Amendment C